

REMARKS

Reconsideration is requested.

Return of an initialed copy of the PTO 1449 Form filed February 27, 2004, pursuant to MPEP § 609, is requested.

Claims 1-11 and 35-40 are pending. Claims 12-34 have been canceled, without prejudice. The Examiner's allowance of claims 6 is acknowledged with appreciation. See, page 6 of the Office Action dated August 11, 2003 (Paper No. 18).

The claims have been further amended above. Support for the additional aspects of claim 1 may be found, for example, on page 5, second and third paragraphs and in the examples (human truncated (tCD34) and deleted (dCD34) CD34 variants). No new matter has been added. The amendments are not believed to raise new issues requiring further consideration and/or search. Entry of the amendments is requested.

The Section 112, first paragraph, rejection of claims 1-5, 7-11 and 35-40 is traversed. Reconsideration and withdrawal of the rejection are requested in view of the above and the following comments.

One of ordinary skill will appreciate that the applicant was in possession of the claimed invention at the time the application was filed.

As admitted by the Examiner, the specification describes three (3) embodiments for CD34 which are expressible surface markers for eukaryotic cells and which are detectable by CD34 detection methods. See, page 3 of the Office Action dated March 24, 2004. It is unclear from the Examiner's remarks how many more exemplifications of the claimed invention would be required to demonstrate for the Examiner that the specification adequately describes the claimed invention.

The Examiner's concerns regarding one's ability to envision changes which may be made in CD34 and still be detectable or identifiable by an antibody against CD34 is not, with due respect, believed to be how one of ordinary skill in the art would approach the interpretation of the present specification and claims. That is, the Examiner appears to believe one of ordinary skill must be taught by the applicants how to change or alter CD34 without losing the ability of being identifiable by an antibody against CD34. See, page 3 of the Office Action dated March 24, 2004. The applicant is not however claiming modified CD34 molecules but rather the claimed invention is a gene transfer vector which includes a novel and non-obvious combination of components which will be recognized by one of ordinary skill in the art. One of ordinary skill in the art does not require a teaching or description from the applicant of how to change or alter CD34 without changing or altering the capacity to be identified by an antibody against CD34 to make and use the claimed invention, as appears to be required by the Examiner.

Claim 1 has been amended to refer to human CD34 in response to the Examiner's specific comment on line 6, page 4 of the Office Action dated March 24, 2004, to advance prosecution, and without prejudice.

Moreover, the variants of claim 1 are specifically exemplified as noted above.

The claims are submitted to be supported by an adequate written description and withdrawal of the Section 112, first paragraph, rejection is requested.

The Section 112, second paragraph, rejection of claims 35-40 is traversed. Reconsideration and withdrawal of the rejection are requested as the inclusion of the alleged "method step" does not make the claims indefinite. Rather, the requirement that the sequence be identifiable by a human CD34 specific antibody is further defined by

the requirement that the amino acid sequence be expressed as a surface marker. The claims are definite and clear to one of ordinary skill in the art.

The Section 102 rejections of claims 1-3, 7-10, 35 and 38-39 over Hawley (U.S. Patent No. 5,962,644), and claims 1-3, 7-10, 35 and 38-39 over Simmons (Journal of Immunology, 1992, Vol. 148, No. 1, pp 267-271), are traversed. Reconsideration and withdrawal of the rejections are requested in view of the above and the following.

The claims require the inclusion of a suicide gene, which is not described in Hawley or Simmons. The applicant submits that selection markers, such as, for example, the neo gene, would not be viewed by one of ordinary skill in the art as suicide genes, even under a very broad interpretation of the term since the effect of a selection marker is believed to be the opposite of that of a suicide gene. That is, selection markers assist the host cell to survive chemical treatment, as appears to be recognized by the Examiner.

The claims are patentable over the cited art. For completeness, the applicant submits, with due respect, that the Examiner's reliance on Simmons is inappropriate in extending an "extremely unlikely" aspect of the art to a "necessarily" inherent property. The Examiner will appreciate that inherency requires that the asserted teaching necessarily flows from the reference. The Examiner's "extremely unlikely" is not believed to raise to the required level of certainty.

Withdrawal of the Section 102 rejections and entry of the above amendments are requested.

The claims are submitted to be in condition for allowance and entry of the above and a Notice of Allowance are requested.

ZANDER
Appl. No. 09/836,602
June 24, 2004

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____



B. J. Sadoff
Reg. No. 36,663

BJS
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100